REMARKS

The Office Action mailed April 3, 2009 has been reviewed and carefully considered. Claims 1-3 and 12 have been amended. Claims 4 and 13 have been canceled without prejudice. Claims 1-3, 5-12 and 14-21 are pending in this application. No new matter has been added.

Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested. It should be noted that the Applicant is not conceding in this application that the amended claims in their prior form are not patentable over the art cited by the Examiner, as the present claim amendments have been made only to facilitate expeditious prosecution of the application. The Applicant respectfully reserves the right to pursue these and other claims in one or more continuation and/or divisional patent applications.

Claim Rejections 35 U.S.C. §101

Claims 1 and 3 stand rejected under 35 U.S.C. §101 for purportedly being directed to non-statutory subject matter. In particular, the Office Action has stated that "determining," "playing" and "selecting" are simply mental steps because they do not recite an apparatus or a device. In addition, the Office Action has also asserted that "[m]entioning a computer in the preamble is not enough, if . . . each of the steps can be performed manually." The Applicant respectfully disagrees.

With regard to the assertions that the claims are directed to mental steps, it is respectfully submitted that playing a digital media file is not a mental step, as a device is used to play back a media file. In addition, concerning the comments regarding manual performance of steps, the Applicant respectfully notes that "manual" is not equivalent to "abstract." Simply because steps may be performed manually using a device does not necessarily mean that the steps are directed to intangible, abstract ideas or principles which fall outside a statutory category of 35 U.S.C. §101. Rather, in accordance with In Re Bilski, a claim need only be tied to a particular machine to be drawn to statutory subject matter under 35 U.S.C. §101. See In re Bilski, 2008 WL 4757110 at *7 (C.A. Fed. 2008) (stating that a claim that is tied to a particular machine or brings about a particular transformation of a particular article is not a principle in the abstract). In any event, the claims have been amended so that prosecution of the application may be expedited.

Claim 1 recites: "wherein the play back apparatus is configured to automatically replay said advertising block in response to receiving a user-command to institute a trick play operation for scanning through a time segment of the media file that is adjacent to said advertising block." In addition, claim 3 recites "playing back said selected media type on the proprietor-authorized play back apparatus, wherein said proprietor-authorized playback apparatus is configured to determine which of said plurality of playback modes is associated with the selected media type and to invoke said advertising scheme by instituting the determined forced advertising play back mode."

Claims 1 and 3 are directed to statutory subject matter at least because they are tied to a particular machine. Specifically, claims 1 and 3 are directed to methods for playing digital media in a playback apparatus that are configured to perform various steps such as automatic replay of media files and determination of playback modes, respectively, as stated above. Accordingly, withdrawal of the rejection is respectfully requested, as claims 1 and 3 are directed to statutory subject matter.

Claim Rejections 35 U.S.C. §103(a)

Claims 1-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,632,992 to Hasegawa (hereinafter 'Hasegawa') in view of U.S. Patent No. 6,694,316 to Langseth et al. (hereinafter 'Langseth').

Prior to addressing the outstanding rejections, the Applicant will briefly summarize certain aspects of the present principles to better assist the Examiner in appreciating the differences between the claimed invention and the cited references. One exemplary aspect of the present invention includes providing a novel method for forcing a user to view or listen to advertising within a digital media file. For example, one means by which a user may attempt to avoid viewing required advertising is simply to let the advertisement run and leave the room or perform some other task during its run so as to not pay attention to the advertisement (see, e.g., Specification, p. 8, lines 9-11). Thereafter, the user may attempt to rewind the digital media file to the very end of the advertisement and view the media file data without having seen the advertisement (see, e.g., Specification, p. 8, lines 9-11). In accordance with one exemplary feature of the present invention, a playback device reading a media file may be configured to automatically jump to the beginning of an advertising block if the user attempts to scan through a time segment after the advertisement

block (see, e.g., Specification, p. 8, lines 9-11). In this way, the user is forced to view or listen to an advertisement even if the advertising has already been played. As discussed herein below, this feature is not disclosed or rendered obvious by any of the references cited in the rejection.

Claim 1 of the present application recites inter alia: "wherein the play back apparatus is configured to automatically replay said advertising block in response to receiving a user-command to institute a trick play operation for scanning through a time segment of the media file that is adjacent to said advertising block."

It is respectfully submitted that Hasegawa and/or Langseth fail to disclose or render obvious automatically replaying an advertising block in response to a user-command to scan through a time segment of a media file that this adjacent to the advertising block. Hasegawa is directed to a method and system for distributing music data with advertisements. While Hasegawa discloses that the price of music data may be reduced if it is appended with advertisements (see, e.g., Hasegawa, column 2, lines 55-60), Hasegawa nowhere discloses or renders obvious automatically replaying an advertisement if a user reverses or fast forwards within a time segment of the media file that is adjacent to the advertisement. Indeed, Hasegawa does not even discuss forced advertising in any way. Furthermore, Langseth fails to cure the deficiencies of Hasegawa, as Langseth is primarily directed to user-personalization of content channels. Similar to Hasegawa, Langseth also fails to disclose any forced advertising methods. Accordingly, the cited references do not render obvious automatically replaying advertising in response to a user attempt to scan through an adjacent time segment, as recited in claim 1.

Thus, claim 1 is patentable over Hasegawa and/or Langseth for at least the reasons discussed above. In addition, claim 2 is patentable over the cited references due at least to its dependency from claim 1.

With regard to claim 3, claim 3 is directed to a proprietor-authorized play back device (see, e.g., Spec., p. 6, l. 28 to p. 7, l. 2) that is configured to apply one of a plurality of different forced playback modes.(see, e.g., Spec., FIG. 2). In particular, claim 3 recites, inter alia:

> A method for playing back a digital media file on a proprietor-authorized play back apparatus comprising the steps of:
>
> defining a plurality of predetermined media types based upon an advertising scheme associated therewith, wherein each media type is associated with one of a plurality of different, forced advertising playback modes;
>
> valuing each of said plurality of predetermined media types in accordance with said advertising scheme;

selecting one of said plurality of media types; and

playing back said selected media type on the proprietor-authorized play back apparatus, wherein said proprietor-authorized playback apparatus is configured to determine which of said plurality of playback modes is associated with the selected media type and to invoke said advertising scheme by instituting the determined forced advertising play back mode.

Firstly, neither Hasegawa nor Langseth disclose or render obvious employing a proprietor-authorized playback apparatus. Hasegawa does not describe any use-limitations on a playback device and Langseth merely discloses transmission of content to devices in accordance with user-preferences (see, e.g., Langseth, column 9, lines 18-22). Secondly, neither reference discloses or renders obvious applying a plurality of different, forced playback modes. As discussed above, neither reference even mentions forced advertising in any way.

In support of the rejection, the Office Action has stated that it would be obvious to force a user to watch advertisements (see, e.g., Office Action dated April 3, 2009, p. 5, para. 4). Assuming, arguendo, that the analysis of the Office Action is correct, the purported obviousness of the references would only extend to a device that forces advertisement play if it is present. It is respectfully submitted that, in view of the references, it is not obvious to apply a plurality of different, forced playback modes to invoke an advertising scheme.

Accordingly, claim 3 is patentable over Hasegawa and/or Langseth for at least the reasons discussed above. In addition, claim 12 recites similar, relevant features discussed above with regard to claim 3. Thus, claim 12 is also patentable over the cited references for at least the reasons discussed above. Moreover, claims 5-11 and 14-21 are patentable over the cited references due at least to their dependencies from claims 3 and 12, respectively. As such, withdrawal of the rejection is respectfully requested.

In view of the foregoing, Applicant respectfully requests that the rejections of the claims set forth in the Office Action of April 3, 2009 be withdrawn, that pending claims 1-3, 4-12 and 14-21 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

The Office is authorized to charge Applicant's Representative's Deposit Account No. 50-1433 in the amount of $405.00 to cover the Request for Continued Examination filing fee.

It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicant's representatives Deposit Account No. 50-1433.

Respectfully submitted,

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